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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/370,504 08/09/99 GALLANT

J RIC-98-047

025537
WORLD COM, INC.
TECHNOLOGY LAW DEPARTMENT
1133 19TH STREET NW
WASHINGTON DC 20036

WM01/1010

EXAMINER

NGO, R

ART UNIT	PAPER NUMBER
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2664

DATE MAILED:

7
10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/370,509

Applicant(s)

MERCHANT ET AL.

Examiner

Ricky Ngo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to the applicant's response filed 7/20/01. Claims 1-24 are currently pending. The IDS submitted on 8/14/01 have been considered by the Examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyao et al. , hereinafter "Miyao", US Patent No. 5,889,777.

- Regarding claim 1-3 and 5, 9-11, Miyao discloses an ATM switched network system (Figs. 5 & 9) for transporting IP packets and a process thereof for achieving that intended purpose. A study of the Miyao's invention reveals that the system and process either expressly or inherently includes a structure having elements and their associated functions which are relative to the limitations or features recited in the claim(s). Note that the disclosure in the reference does not need to describe in identical words as used in the claim(s) to be anticipatory. In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990).

Comparison between the claimed subject matter and the subject matter disclosed by the reference is identified hereafter: an ATM switched network system (Figs. 5 & 9) for transporting IP packets from a calling party (105, 104) to a called party (106, 101-103). Fig. 9 shows the system including a calling terminal and called terminal, also known as

first access control manager (e.g. the network server 161 connecting the calling terminal and the ATM-SW 170), an ATM network (ATM-SW) and a second access control manager (e.g. the network server connecting the ATM-SW 170 and the called terminal). The access control manager has IP and ATM capability such as capable of accessing IP and ATM physical medium. Fig. 4 shows that the first and the second access managers (the network servers) assign IP addresses to the calling party and the called party, respectively for transporting IP media between the access managers (servers) and the parties over the IP physical medium, and convert the IP media into the ATM cells using ALL5 for transporting the cells over an established virtual circuit of the ATM switched network between the access managers. It should be understood that the IP addresses are temporarily assigned to the users.

- Regarding claims 4 and 6, It was known for the media transmission over the ATM virtual circuit each terminal is temporarily assigned with an ATM address such as a combination of VPIs and VCIs, by the network server.

- Regarding claim 7 & 8, Miyao further discloses a address pool (e.g. the Cache 102) for storing IP and ATM addresses which are assigned to the calling and called parties.

- Regarding claims 12-24, a review of the limitations of claims 12-24 reveals that they closely parallel the limitations addressed in connection with the earlier claims (1-11). For

sake of brevity, it is believed that the reasons for rejecting the limitations of the earlier claims apply to claims 12-24.

Response to Arguments

3. Applicant's arguments filed 7/20/01 have been fully considered but they are not persuasive..

- Examiner would like to clarify that the claimed calling and called parties are interpreted as one of the terminals 101-106 shown in Fig. 9 and the claimed calling and called terminals as one of the servers 161-163 shown in Fig. 9.

- In response to that "Miyao does not disclose IP telephone session." Examiner respectfully disagrees. Fig. 10 of Miyao shows a protocol stack for data transfer in IP subnetworks through an ATM virtual LAN, wherein the data are multimedia data including voice, video, data, and/or facsimile data. Therefore, it would be inherent to one skilled in the art to recognize the system of Miyao supports the arguable above.

- In response to that "Miyao does not disclose the calling party." Examiner respectfully disagrees. The claimed calling party equals to one of the servers 1-1-163 of Fig. 9.

- In response to that "Miyao does not disclose transporting any media between the first device and the second device." Examiner respectfully disagrees. The physical medium shown in Figs. 10-11 inherently have the capability of transporting multimedia data.

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- Because the arguable features are supported by the Miyao reference, therefore, all claims remain rejected under 102(e) as set for the above.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky Q. Ngo whose telephone number is 703-305-4798. The examiner can normally be reached on MaxFlex Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 703-305-4366. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-308-6606 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **703-305-3900**.



Ricky Ngo
Primary Examiner
Art Unit 2664

October 9, 2001